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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,881	03/15/2004	Steven Lawrence Fors	144584IT (15334US01)	4487

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EXAMINER

CUMMING, WILLIAM D

ART UNIT	PAPER NUMBER
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2617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/801,681

Applicant(s)

FORS, RAI, & MORITA

Examiner

WILLIAM D. CUMMING

Art Unit

2617

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plurality of remote systems must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
2. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Specification

4. The use of the trademark BLUETOOTH has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

5. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

6. Applicants are reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

7. The abstract of the disclosure is objected to because implied phrases.

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

8. Claims 5 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

If the trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of the 35 U.S.C. 112, second paragraph. *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name. If a trademark or trade name appears in a claim and is not intended as a limitation in the claim, the question of why it is in the claim should be addressed. Does its

presence in the claim cause confusion as to the scope of the claim? If so, the claim should be rejected under 35 U.S.C. 112, second paragraph.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1, 3, 4, 5, and 7-20 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Pulkkinen, et al.**

Pulkkinen, et al discloses a wireless communication system (figure 1) for facilitating clinical workflow. The system comprising a remote system (#12) in a healthcare facility. The remote system (#12) used for at least one of executing an operation, storing data, and retrieving data (figure 2). A wireless communication device for voice control of said remote system (*"In a preferred embodiment, the system includes a controller coupled by a wireless, wired or combination wired and wireless network to sensors, identification badges, physiological output data monitoring equipment and portable or fixed interfaces, each of which is located within a tracking environment. Each of the badges is either an active device, such as an IR or RF transceiver which automatically or*

upon manual triggering or detection of a trigger signal transmits encoded identification data signals, a passive device, such as an RF transponder or an IR readable barcode which when interrogated respectively by an RF or IR source reflects encoded identification data signals, or a combination active and passive device. The badges can be located or carried directly on or adjacent to patients, caregivers and fixed or portable diagnostic or medication dispensing equipment. The output monitoring equipment is coupled to medical diagnostic or treatment equipment, or to existing data networks to which the medical equipment may already be coupled. The monitoring equipment further includes a transmitter that transmits to the controller time encoded activity data signals representative of physiological conditions, such as vital signs, that the medical or diagnostic equipment measures, as well as the identities of the caregiver operating the medical equipment and the patient being monitored. The interfaces preferably include a graphical display, manual or voice data input capabilities and a transceiver apparatus which receives control signals from and transmits energy signals including activity data and other data, such as instructions for modifying a patient care schedule, manually input by a caregiver to the controller, preferably over a hardwired electrical or optical data signal communication link. The sensors are energy signal transceivers which detect IR and/or RF encoded identification data signals and transmit to the controller, also preferably over the hardwired link, digital activity data signals representative of the detected identification data signals. Preferably, the sensors are positioned at strategic, predetermined

locations throughout a tracking environment to ensure complete and accurate monitoring. In a preferred embodiment, the collected activity data is representative of IR or RF energy signal interaction between a sensor and the badge of a patient or caregiver, or between the badge of a patient and the badge of a caregiver.”) in said healthcare facility. The wireless communication device (19 & 16) allowing centralized control of said remote system to facilitate at least one of executing an operation, storing data, and retrieving data (figure 2) and an interface for relaying communication between said remote system (#12) and said wireless communication device (#19, 16), said interface displaying data from said remote system (“The interface 21 preferably is a microprocessor based graphical display, such as a flat screen monitor, including an input device, such as a keypad or a keyboard. The interface 21 includes a RF transceiver assembly which transmits to the controller 12 digitally encoded RF activity data signals, based on data that a caregiver enters concerning a care event, for example, data indicating that the caregiver administered medication to the patient at a particular time. The interface 21 furthermore receives RF control signals transmitted from the controller 12 and instructing the interface 21 to, for example, display text data or cause an attached or an integrated annunciator or light source to sound or illuminate, respectively. In a preferred embodiment, the interface 21 is a PDA or keypad-based data entry device including a IR barcode scanner or a smart card reader. In an alternative preferred embodiment, the interface 21 is coupled to a

wired LAN to which all components of the system 10, except for caregiver and patient badges, are coupled.”)

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Pulkkinen, et al** in view of **Bosen**.

Regarding claim 6, **Pulkkinen, et al** disclose all subject matter, except the wireless communication device is a wireless headset. **Bosen** teaches the use of a wireless headset (figure 3) in a wireless communication system for facilitating clinical workflow for the purpose of voice sound transmitting and receiving that permits hands free communication over a wireless communication linkage. Hence it would have been obvious for one of ordinary skill in the art at the time the claimed invention was made to incorporate the use of the wireless communication device being a wireless headset as taught by **Bosen** for the purpose of voice sound transmitting and receiving that permits hands free communication over a wireless communication linkage in the wireless communication system for facilitating clinical workflow of **Pulkkinen, et al** in order for the user to have hands free communications with the remote system.

Regarding claim 2, *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960), the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.

Double Patenting

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

16. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

17. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

18. Claims 1-20 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/991,570. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are broader than the ones in the co-pending application.

19. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

20. These nonstatutory double patenting rejections **CANNOT** be held in abeyance. Applicant **MUST** either traverse the nonstatutory double patenting rejection or file a terminal disclaimer. If applicant does **NOT** either traverse the nonstatutory double patenting rejection or file a terminal disclaimer it will be consider a **DELIBERATE** non-responsive response and the application maybe **ABANDONED**.

21. Claims 1-20 of this application conflict with claims 1-23 of Application No. 10/991,570. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicants are required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

22. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

23. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

24. Claims 1-20 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-23 of copending Application No. 10/991,570. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Simmon, et al disclose a data acquisition and retrieval system with wireless handheld user interface.

Keck discloses a hospital emergency department resource utilization and optimization system.

26. If applicants wish to request for an interview, an *"Applicant Initiated Interview Request"* form (PTOL-413A) should be submitted to the examiner prior to the interview in order to permit the examiner to prepare in advance for the interview and to focus on the issues to be discussed. This form should identify the participants of the interview, the proposed date of the interview, whether the interview will be personal, telephonic, or video conference, and should include a brief description of the issues to be discussed. A copy of the completed *"Applicant Initiated Interview Request"* form should be attached to the Interview Summary form, PTOL-413 at the completion of the interview and a copy should be given to applicant or applicant's representative.

27. Electronic Notification of Outgoing Correspondence (e-Office Action)

Effective December 16, 2006, the United States Patent and Trademark Office (Office) will begin a pilot program to provide a limited number of Private PAIR users with the option of receiving electronic notification of some outgoing correspondence related to their US patents and US national patent applications retrievable through Private PAIR instead of a paper mailing of the correspondence. Patent Cooperation Treaty (PCT) applications will not be included in this pilot.

Participants in this pilot program will no longer receive paper mailings for most correspondence originating from a Technology Center. However, since several areas of the Office have independent mailing processes, pilot participants will continue to receive paper mailings for correspondence originating from several areas of the Office including, but not limited to: Office of Initial Patent Examination, Petitions, PCT, Appeals, Publications, Interference, and Reexamination.

A Private PAIR user will be able to opt-in to receive electronic mail message (email) notifications of outgoing correspondence by selecting the appropriate choice on the Customer Number Details screen for a customer number associated with a correspondence address after logging in to Private PAIR and providing between one and three email addresses to be used for these notifications. The Private Pair user must be a registered patent attorney or agent of record, or a pro se inventor who is a named

inventor in the application associated with the customer number through which Private PAIR is accessed, The Office will then send a notification to each provided email address if a new outgoing correspondence has been prepared for the patents or patent applications associated with the user's Customer Number. Each email notification will list all applications, associated with the corresponding Customer Number, in which new outgoing correspondence was prepared for the corresponding electronic application files within the preceding 24 hours. Each email notification will be entered into the corresponding application files. The new outgoing correspondence will become available for viewing and downloading through Private PAIR within two business days of the date of the email notification.

Applicants will have the ability to opt-in or opt-out of receiving electronic notification of Office actions at any time. However, the status of each individual outgoing correspondence, whether electronic or paper, will be determined at the time of the printing of the form PTOL-90 cover sheet (at the time the outgoing correspondence becomes available for viewing, i.e., the date indicated on the correspondence).

The email notification described above will be sent after the Office action has been prepared and entered into the record. The period for reply to any Office correspondence to which a reply is required will commence on the date indicated on the outgoing Office such outgoing correspondence for all other purposes (e.g., 37 CFR 1.71(g)(2), 1.97(b), 1.701 through 1.705). The Office communication will become available for downloading and viewing through Private PAIR on the date indicated on the correspondence.

If none of the documents in each of the applications listed in the email notifications are viewed or downloaded through Private PAIR within seven calendar days after the emails are sent, a courtesy postcard notifying the applicant of the availability of electronic Office action will be mailed to the correspondence address associated with the applicant's corresponding Customer Number for each of those applications. The mailing of a courtesy postcard will not restart the time period for reply, and the period for reply to any outgoing Office correspondence to which a reply is required will continue to be measured from the date indicated on such outgoing Office correspondence.

Please note that the email notification procedure outlined above is simply an automated email sent by the Office to alert applicant that an official Office correspondence has been entered in the official record that will be available for viewing via private PAIR. It is not an email sent by the examiner and does not alter the Office policy prohibiting an applicant or examiner from engaging in improper email correspondence. See MPEP section 502.03.

The e-Office Action Pilot Program will begin with a limited number of participants. The Pilot Program will last approximately six months. Upon the conclusion of the pilot program the success of the pilot will be evaluated. At that time decisions will be made as to whether or not to make modifications to the e-Office action program and whether or not to permanently implement the program.

Thus, if the pilot program is successful and a decision is made to permanently implement the program, it is expected that the e-Office Action Program will go into full

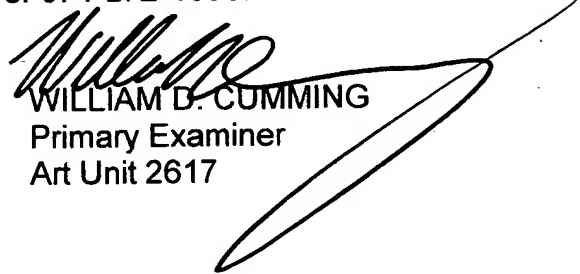
production sometime around June 2007 at which point the program will be open to all users (registered patent attorney or agent of record, or a pro se inventor who is a named inventor in the application associated with the customer number through which Private PAIR is accessed) having a Customer Number and access to Private PAIR.

For further information please contact the Patent Electronic Business Center (EBC) 866-217-9197 (toll-free) or 571-272-4100 Monday through Friday from 6 a.m. to 12 Midnight Eastern Time or send e-mail to ebc@uspto.gov
Date 12/19/2006

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WILLIAM D. CUMMING** whose telephone number is 571-272-7861. The examiner can normally be reached on Monday-Thursday 11am-8:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on 571-272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


WILLIAM D. CUMMING
Primary Examiner
Art Unit 2617

wdc